

REMARKS

Claims 1-11 are pending in this application.

Rejections under the judicially-created doctrine of obviousness-type double patenting

Claims 1-10 have been rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 3, 6-12 and 17 of U.S. Pat. No. 6,270,998 B1 ("the '998 patent"). A terminal disclaimer has been filed, thus obviating the rejection.

Rejection under 35 U.S.C. §112, 1st paragraph

Claim 11 has been rejected under 35 U.S.C. §112, 1st paragraph for lack of enablement. Specifically, the Examiner notes that the amino acid sequence recited in claim 11 is the intracellular domain of Fas. The Examiner takes the position that if the amino acid sequence of claim 11 is expressed in a host cell, the polypeptide would be located in the interior of the cell and therefore not be antigenic. The Examiner further notes that if the entire Fas antigen is expressed on the host cell, any antibodies would be raised against the extracellular domain, not the recited sequence of claim 11. Applicants traverse this rejection and withdrawal thereof is respectfully requested.

The Examiner is correct that the invention of claim 11 encompasses antibodies that recognize the intracellular domain of Fas. However, claim 11, as amended, recites a method of producing an antibody by transfecting a host cell with the DNA of claim 1 or 2; injecting the host cell into an animal to produce antibodies; and isolating said antibodies from the animal. When the host cell is transfected with the DNA encoding the intracellular domain of Fas, the polypeptide would be expected to be located within the cell, as noted by the Examiner. However, when the transfected host cell is then injected into an animal, the cell will be attacked by T cells of the animal and the intracellular peptides, including the intracellular domain of Fas, will be released, becoming antigenic and giving rise to antibodies. This mechanism of creating antibodies is a standard mechanism by which animals mount an immune response. As such, one skilled in the art would find the invention of claim 11 to be fully enabled and withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. §112, 2nd paragraph

Claims 1-11 have been rejected under 35 U.S.C. §112, 2nd paragraph as being unclear. More specifically claims 1 and 10-11 have been rejected for recitation of "amino acid sequence of No. 175 to 319." Claims 10-11 have been rejected for improper dependencies. Claim

BEST AVAILABLE COPY

11 has been rejected for not reciting positive method steps. Finally, the dependent claims have further been rejected for recitation of "comprising." The Examiner asserts that if claim 1 recites "consisting of," the dependent claims cannot then recite the open language of comprising because the dependent claims would be more broad than the independent claim 1.

Claims 1 and 10-11 have been amended to address and overcome the issues raised by Examiner and render the scope of the claims more clear. In addition, claim 3 has amended to be in independent form and claim 4 has been amended to depend from claim 3. As such, the issue regarding the breath of the dependent claims and all other issues under 35 U.S.C. 112, second paragraph have been addressed. Withdrawal of the rejections is respectfully requested.

Rejections under 35 U.S.C. §102(b)

Claim 11 has been rejected under 35 U.S.C. §102(b) as being anticipated by Yonehara et al. Claim 11 has been amended to explicitly recite the steps of transfecting the host cell, injecting the host cell into an animal and isolating the antibodies, as suggested by the Examiner. Withdrawal of the rejection is respectfully requested.

BEST AVAILABLE COPY

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact MaryAnne Armstrong, PhD (Reg. No. 40,069) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By MaryAnne Armstrong
Gerald M. Murphy, Jr., #28,977

MaryAnne Armstrong, PhD, #40,069

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

GMM/MAA:bmp
0020-4877P

BEST AVAILABLE COPY